



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,035	09/24/2003	Angelica Alvarado	10177-233	5049

20583 7590 09/01/2004

JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,035

Applicant(s)

ALVARADO ET AL.

Examiner

Tatyana Zalukaeva

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 13 is objected to because of the following informalities: It is unclear what the parenthesis on the "heptadecylfluorodecyl methacrylate" mean and why required. Appropriate correction is required.
2. Claims 10 13 are objected to because the term "heptadecylfluorodecyl methacrylate" should be named at least heptadecafluorodecyl methacrylate .

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 5, 6, 7, 8, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Froix (U.S. 5,163,952).

Froix discloses a stent, which can carry medical agents such as thrombolytic agents, growth factors, and slow release medications (col.2, lines 1-5). The stent of

Art Unit: 1713

Froix is composed primarily of (meth)acrylate copolymers. Such, Example 10 in col.7 provides for a copolymer:

Isobornyl methacrylate 0.3 gram

N-vinyl pyrrolidone 0.2 gram

Butyl acrylate 0.45 gram

Polyethylene glycol dimethacrylate

0.05 gram

Benzoyl peroxide 0.004 gram

This clearly reads on the limitations of the instant claims 1, 2, 4, 5, 6, 7, 8, 12.

5. Claims 1, 2, 4- 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Luttenberger (U.S. 5,136,000).

Luttenberger discloses crosslinkable polymer dispersion obtained by the copolymerization of from about 25 to about 35% wt. butyl methacrylate, from about 10 to about 25% wt. ethyl hexyl acrylate and/or n-butyl acrylate, from about 10 to about 20% wt. methyl methacrylate, from about 10 to about 20% wt. styrene, from about 1 to about 30% wt. methacrylic acid and/or acrylic acid, and from about 10 to about 25% wt. polypropylene glycol monomethacrylate and/or polyethylene glycol monomethacrylate. (col.4, lines 29-40).

6. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Toyooka U.S. 5,288,825.

Art Unit: 1713

Toyooka discloses a polymer prepared by copolymerization of monomer , 50 parts of methyl methacrylate, 30 parts of butyl acrylate, 20 parts of 3,3,4,4,5,5,6,6,7,7,8,8,9,9,10,10,10-heptafluorodecyl methacrylate (17FM) and 0.5 part of n-octylmercaptan in the presence of 1.5 parts of sodium dioctylsulfosuccinate, 4.0 parts of cumene hydroperoxide (Example 1 in col.6).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 1713

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 10 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamashita (US 6,631,233 B2). Yamashita discloses a copolymer obtained from three monomeric components. They included 2,2,3,3-tetrafluoropropyl methacrylate (4FM) giving a homopolymer with a refractive index (n.sub.d) of 1.4215 and a Tg of 64.degree. C., 2,2,3,3,3-pentafluoropropyl methacrylate (5FM) giving a homopolymer with Tg of 67C., and 2-(perfluorooctyl)ethyl methacrylate (17FM). 17FM is a structural analog of heptafluorodecyl methacrylate. Therefore, according to MPEP 2131.02 one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic teaching of Yamashita's comonomers and the copolymer is anticipated. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). In the event that one of the ordinary skill in the art would not immediately envisage Applicants' instantly claimed copolymer, then the composition is rendered obvious from the disclosure found in the prior art. The prior art contains each of Applicants' instantly claimed comonomers and clearly suggests to one of ordinary skill in the art that they be used in combination as claimed. Such a suggestion renders obvious applicants' instantly claimed copolymer, and as such, the claim is not patentable.

Example 3 in col. In col.11 provides for the following copolymers:

5FM/17FM=78.67/21.33

5FM/17FM=62.11/37.89

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Froix.

Froix does include fluorinated acrylates, such as hexafluorobutyl methacrylate (Example 2 in col. 4). He does not specifically disclose permutations, such as per instant claim 11, however, each comonomer of claim 11 is disclosed as principle monomer in a different composition (see example 1, col.4, , examples 4, 5,). Since structural similarities have been found to support a prima facie case of obviousness, e.g., In re May, 574 F.2d 1082, 1093-95, 197 USPQ 601, 610-11 (CCPA 1978), In re Wilder, 563 F.2d 457, 460, 195 USPQ 426, 429 (CCPA 1977) ; In re Hoch, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (CCPA 1970) ; In re Druey, 319 F.2d 237, 240, 138 USPQ 39, 41 (CCPA 1963), therefore, in the instant case teaching of a structural similarity motivates one skilled in the art to suggest selection of the claimed species or subgenus.

Allowable Subject Matter

12. Claim 14 is allowed over the prior art of record. The specific composition disclosed in claim 14 is neither anticipated, nor suggested fairly by the prior art references of record.

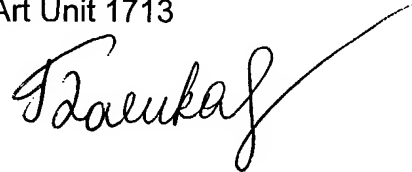
Art Unit: 1713

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva
Primary Examiner
Art Unit 1713



August 23, 2004